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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/616,608	07/14/2000	Chika Honda	KOT-0014	6146

7590 02/11/2004  
Cantor Colburn LLP  
55 Griffin Road South  
Bloomfield, CT 06002

EXAMINER

CHURCH, CRAIG E

ART UNIT PAPER NUMBER

2882

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/616,608

Applicant(s)

HONDA ET AL.

Examiner

Craig E. Church

Art Unit

2882

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/10/03
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,5-11 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,5-11,26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:**

**A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.**

**Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.**

**Claims 2, 5-11 and 26 are rejected under 35 U.S.C. § 103 as being unpatentable over Wolbarst in view of Coe (5305365). Wolbarst describes the characteristics of an x-ray mammograph and specifically teaches that they employ a molybdenum target (page 220) with a focal spot of .1 mm (page 197) and a minimum source-to-image distance of 40 cm (page 202). Coe teaches that a mammograph may be operated with a source-to-image distance of 76 cm, and with a magnification of 1.5 as recommended by Wolbarst (page 221), the source-to-object distance would be 50 cm. It is obvious that applicant's claims read on the Wolbarst mammograph with a focal spot size of .1 mm (100 microns), SID of 76 cm and SOD of 50 cm.**

**Applicant's arguments filed November 10, 2003 have been fully considered but they are not persuasive. Applicant's assertion that the prior art**

**must teach the formulas recited in the claims is not reasonable or correct. Rather it is only necessary that the prior art define a set of parameters that satisfies said formulas as is demonstrated above.**

**Applicant's attempt to discredit the disclosure of Wolbarst must be in vane (the declaration notwithstanding) as Wolbarst is utilized as a teaching textbook in radiology throughout the world, and the rejection does not suggest modifying either the Wokbarst or the Coe apparatus as argued by applicant but only that Coe reveals the common source-to-image distance of 76 cm.**

**As has been clearly established in the courts, it is not required that eirther reference specifically point to the other, rather the hypothetical person of ordinary skill in the art may be motivated to combine prior art teachings by his own common sense and general knowledge. See for example:**

**In re Nilssen, 7 USPQ2d 1500, 1988**

**Milliken Research v. Dan River Inc, Federal Circuit, 1985**

**Ex parte Obiya, 227 USPQ 59, 1985**

**Ex parte Clapp, 227 USPQ 972,973, 1984**

**In re Keller, 208 USPQ 871, 1981**

**In re Jacoby, 135 USPQ 317, 1962**

**In re Sernaker, 217 USPQ 1.6, 1983 where the Court declared**

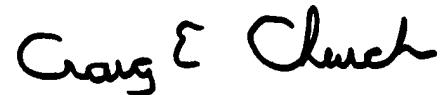
**The (district) court has said, and we agree, it is not necessary that the prior art suggests expressly or in so many words the "changes or improvements" the inventor has made. It is only necessary that he apply "knowledge clearly present in the prior art."**

**Art Unit: 2882**

**THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).**

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**Any inquiry concerning this communication should be directed to Examiner Church at telephone number (571) 272-2488.**

A handwritten signature in black ink that reads "Craig E Church". The signature is written in a cursive, flowing style.

**CRAIG E. CHURCH**  
Senior Examiner  
ART UNIT 2882